

REMARKS

The foregoing amendments and the following remarks are submitted in response to the communication dated August 2, 2005.

Status of the Claims

Claims 29-31 and 67-73 are pending in the application. Claims 29, 30, 31, 67, 68, 69 and 70 have been amended in order to more particularly point out and distinctly claim that which Applicants regard as the invention. Applicants have amended withdrawn claims 67-70, which are withdrawn process claims, to include the limitations of the product claims. Support for the amended claims can be found generally through Applicants' specification.

New Rejection or Objections

Claim Rejections – 35 U.S.C. §112

Claims 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner asserts that because the claims recite "**corresponding** to 40% formamide with 5X or 6X SSC", they read on other stringency conditions, and the resulting claims do not clearly set forth the metes and bounds of patent protection desired. Applicants submit that the specification provides a clear definition of hybridization conditions, including at page 37, and assert that the skilled artisan can readily determine and use equivalent hybridization conditions. Applicants have above amended claims 29-31 to clarify the hybridization language, referencing "moderate stringency hybridization conditions" for clarity, which is exemplified, as set out in the specification at page 37 lines 19-20, in the 40% formamide with 5X or 6X SSC conditions. The skilled artisan can and would readily assess and determine equivalent conditions to those called out in the claim. The artisan may not use formamide and/or SSC in his hybridization, but could experimentally determine equivalent conditions using his own buffers, washes and temperatures. He would simply experimentally compare his selected conditions side-by-side with 40% formamide, 5X or

6X SSC conditions, including appropriate controls, to identify the most appropriate hybridization and buffer combination to be equivalent. Claim 30 is rejected as indefinite because it recites “consisting essentially of” amino acids 28-205 of SEQ ID NO: 10, the phrase in quotes referring to compositions and not properly to proteins. Claim 31 is indefinite in the phrase “having a nucleotide sequence”, which the Examiner suggests should be “having the nucleotide sequence”. Applicants respectfully disagree with the rejections of claims 30 and 31, however, without prejudice to further prosecution, the rejected claims have above been amended to address the Examiner’s rejections. Applicants request that these new 35 U.S.C. 112, second paragraph, rejections be withdrawn.

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated DNA molecule of SEQ ID NO: 9, does not reasonably provide enablement for an isolated DNA molecule encoding on expression a soluble leptin receptor which is the complement of SEQ ID NO: 9. The Examiner remarks that the complement of SEQ ID NO: 9 would not encode the leptin receptor. Applicants have above amended claim 29 and request that this 35 U.S.C. 112, first paragraph, rejection be withdrawn.

Maintained Rejections

Claim Rejections - 35 U.S.C. §112

Claims 29 and 30 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner asserts that claims 29 and 30 each encompass a specific nucleic acid sequence encoding a specific polypeptide, or allelic variants thereof, which would not have the same sequences. Applicants respectfully disagree and point out that claim 29 as presently pending, does not contain the language “or allelic variants thereof”.

In view of the foregoing remarks and amendment, Applicants submit that the Examiner’s rejections under 35 U.S.C. 112, first paragraph, may properly be withdrawn.

Claim Rejections - 35 USC § 102

Claims 29-31 remain rejected under 35 U.S.C. 102(e) as being anticipated by Tartaglia et al U.S. Patent No. 6,506,877, filed December 28, 1995. The Examiner asserts that the vast majority of oligonucleotides as claimed would hybridize to the nucleotide sequence of Tartaglia et al, in the region from nucleotides 44-2388 of SEQ ID NO: 9. Applicants again assert that Tartaglia does not teach or anticipate the particular soluble receptor(s) claimed by Applicants. Tartaglia does not anticipate the soluble receptor(s) of the instant Application, particularly in as much as the C-terminal sequence of this soluble receptor diverges and specific oligonucleotides which hybridize to the OB-Re soluble leptin receptor but not to the Tartaglia receptor exist and can be designed. As noted in the instant Specification at page 24 line 22, the amino acid sequence of the Tartaglia et al mouse OB-R is set forth in SEQ ID NO:84. Applicants pending claims are directed to oligonucleotides specifically hybridizable to nucleic acids encoding the soluble leptin receptors OB-Re (SEQ ID NO: 10) or amino acids 28-805 of SEQ ID NO: 10, wherein said oligonucleotide does not hybridize under moderate stringency hybridization conditions to nucleic acid encoding the leptin receptor polypeptide of SEQ ID NO: 84. The claims as now presented are not taught or anticipated by Tartaglia et al.

In view of the foregoing remarks and amendments, Applicants submit that the Examiner's rejection under 35 U.S.C. 102 may properly be withdrawn.

CONCLUSION

Applicants respectfully request entry of the foregoing amendments and remarks in the file history of the instant Application. The Claims as amended are believed to be in condition for allowance, and reconsideration and withdrawal of all of the outstanding rejections is therefore believed in order. Early and favorable action on the claims is earnestly solicited.

Respectfully submitted,

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